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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/370,417	08/09/99	BERG	J 8942.30US

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PM92/0209

EXAMINER

KIM, H

ART UNIT	PAPER NUMBER
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3629

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DATE MAILED:

02/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/370,417**

Applicant(s)  
**Berg et al.**

Examiner  
**Harry C. Kim**

Group Art Unit  
**3629**



☒ Responsive to communication(s) filed on Nov 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 18-31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 20-23, 27-28, and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wong. Wong discloses all of the claimed structural limitations of an integral plastic retainer clip 12 comprising a first portion 18, a second portion 20 hingedly attached to the first portion 18 at one end 22 and selectively engageable to the first portion 18 at the other end 50, a first retaining area 28, a second retaining area 30, a finger 40, and a notch 42 for receiving the finger 40 for separating the first and second retaining areas.

Claims 18, 20-24, 26-28, and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Guido et al. Guido et al. discloses all of the claimed structural limitations of an integral plastic retainer clip 1 (Figs. 1-3) comprising a first portion 6, a second portion 5 hingedly attached to the first portion at one end 8 and selectively engageable to the first portion at the other end, a first retaining area 3, a second retaining area 4, a finger 12, and a notch 14 for receiving the finger 12 for separating the first and second retaining areas.

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Applicant is reminded that the limitation of the retainer clip being used for retaining the fence strand members in the retaining areas is deemed intended use and thus, cannot be given patentable weight since the claims are directed only to the retainer clip and not in combination with the fence strand members.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 24-26, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Matsui.

As regards to claims 19 & 29, Wong, discussed above, shows both of the first and second retaining areas having circular loops rather than the first area having the circular loop and the second area having a rectangular area as claimed. Matsui teaches an integral plastic retainer clip (Fig. 2) comprising a first portion 16 and a second portion 14 hingedly attached to the first portion at one end and selectively engageable to the first portion at the other end to define a circular loop retaining area for clamping a circular element therein. Further, Matsui also teaches that the retaining area may be in the form of a rectangular area (Fig. 16) for clamping a flat elements therein. Therefore, as taught

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by Matsui, it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to enhance the overall utility and effectiveness of the retainer clip of Wong by modifying the second area to have the rectangular area or any other geometry for accommodating the corresponding shape of the element clamped therein.

As regards to claims 24-26, Wong, discussed above, shows the clip 12 having a locking arrangement 50 & 52 but fails to show the first portion having a tapered locking shoulder for engaging with a tapered locking tab having a finger actuated tab of the second portion as claimed. Matsui teaches a similar retainer clip (Figs. 2-8) comprising a first portion 16 having a tapered locking shoulder 28 for engaging with a tapered locking tab 20 having a finger actuated tab 24 of a second portion 16 for facilitating engagement/disengagement between the first and second portions. Therefore, as taught by Matsui, it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to enhance the overall effectiveness of the retainer clip of Wong by providing the first portion with a tapered locking shoulder and providing the second portion with a corresponding tapered locking tab having a finger actuated tab to facilitate engagement/disengagement between the first and second portions.

### ***Double Patenting***

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214

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USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-31 are provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No. 08/909,286. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 18-31 are rejected under the judicially created doctrine of double patenting over the claims of U.S. Patent No. 5,975,501 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully

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disclosed in the patent and is covered by the patent since the patent and the instant application are claiming common subject matter. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.


### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Langlie et al. '255, Briggs, Boisvert, Brown, Blase et al., and Wells, Jr. show similar retainer clip assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Harry C. Kim whose telephone number is (703) 308-2248.

Any inquiry of a general nature or relating to the status of this application should be directed to the Tech Center receptionist whose telephone number is (703) 308-2168.

HCK  
February 7, 2000

  
**HARRY C. KIM**  
**PRIMARY EXAMINER**  
**TECH CENTER 3600**